

In re Patent Application of:
Gerald A. Pierson et al.

Serial No. 09/938,288

REMARKS

In the Final Office Action, the Examiner once again rejected Claims 42-43 under 35 U.S.C. § 103(a) as being obvious, and therefore unpatentable, over a single patent document, namely Rhode et al., U.S. Pat. No. 5,882,555 ("Rhode") (*see* Final Official Action, Page 2, No. 1, para. 2). Applicants respectfully disagree.

Claims 42-43 are Nonobvious:

Applicants once again submit that independent Claim 42 and dependent Claim 43 are nonobvious over Rhode, and that the Examiner has not set forth a proper *prima facie* case of obviousness as set forth by both the Federal Circuit and the MPEP. As noted in Applicants previous responses, and discussed in more detail below, to establish a *prima facie* case of obviousness, three basic criteria must be met. *See In re Vaeck*, 979 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP §§ 2142, 2143 – 2143.03.

No Suggestion or Motivation to Modify or Combine:

First, as the Examiner is aware, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. *See In re Vaeck*, 979 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) (if an obviousness rejection is based on a single reference, then there must be a suggestion or motivation in the reference to modify the teachings or disclosures of that reference); MPEP § 2143.01. Furthermore, there are three types or sources of motivation to modify or combine: (1) the nature of the problem; (2) the teachings of the prior art; and (3) knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (although the combination of references taught every element of the claimed invention, because there was no motivation to combine, a rejection based on obviousness was held improper); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); MPEP § 2143.01. Although the suggestion or motivation to modify the single reference may flow from the nature of the problem being solved, *see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), "defining the problem in terms of its solution reveals improper hindsight in the selection of the

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prior art relevant to obviousness." *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 880 (Fed. Cir. 1998). Additionally, the motivation or suggestion of the prior art reference may be explicit or implicit from the prior art reference as a whole. See *WMS Gaming, Inc. v. Inter'l Game Tech.*, 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999); MPEP § 2143.01. Furthermore, the "test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)); MPEP § 2143.01.

Although the "the level of skill in the art is a prism or lens through [to view] the prior art and the claimed invention," the level of skill in the art is merely a "reference point that prevents [the Examiner] from using their own insight or, worse yet, hindsight, to gauge obviousness." *Al-Site Corp. v. VSI Int'l, Inc.*, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999). As noted by the Federal Circuit "[r]arely ... will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment." *Id.* (citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.")). "Skill in the art does not act as a bridge over gaps in substantive presentation of an obviousness case, but instead supplies the primary guarantee of objectivity in the process." *Al-Site Corp. v. VSI Int'l, Inc.*, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999) (citing *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991)). Finally, in evaluating "the propriety of the Patent Office case for obviousness ... it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Examiner Improperly Uses Applicants' Application as Motivation to Modify:

With these basic premises set forth by the Federal Circuit and CCPA regarding the suggestion or motivation to modify or combine, and after reviewing the Examiner's Final Office

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Action, with respect to Claims 42-43, Applicants believe that the crux of the misunderstanding between the Applicants and the Examiner relates to why it would be obvious to one skilled in the art to add additional layers or material to a digitally encoded disc when the prior art method is aimed at removing material from a blank, typically a round blank disc (Col. 2, lines. 48-54).

As an initial observation, Applicants submit that Rhode is directed at placing labels on and "mass producing non-round" disc (Col. 1, line 65 to Col. 2, line 7). Applicants' invention, in contrast, is for a method of "molding" a disc "having a major elevational portion bounded by first and second pairs of spaced-apart outer side peripheries defining outer boundaries of at least portions of the disc, each of the first pair of spaced-apart peripheries arcuately extending between each of the second pair of spaced-apart outer side peripheries extending substantially linearly between each of the pairs of spaced-apart outer peripheries" (Application, Claim 42). Applicant would further submit that the misunderstanding centers on the Examiner's and Applicants' different use or meaning of the word "mold."

The Examiner uses the word "mold" to describe the process of manufacture disclosed, taught and claimed by Rhode. This process begins with the use of a "blank" that then has digital information printed on the disc, applying a label to the top of the disc, and then "shaping" (Rhode claim 1), "removing portions of the blank" (Rhode, claim 10), or "grinding" (Col. 4, lines 1-5) the disc to achieve a non-round disc (*see also*, Col. 2, line 47 to Col. 4, line 59). An alternate embodiment disclosed by Rhode is the use of a stamping process to cut the shape out of a blank disc using a male and female "mold" (Col. 4, lines 22-37). When Rhode is viewed in the totality of what is disclosed, taught and claimed, Rhode is directed at using a blank disc that has some portion or portions removed by shaping, grinding, or stamping to produce a non-round disc. Applicants, in contrast, use of the word "mold" to describe:

a method of forming a trading card optical compact disc according to the present invention preferably includes molding at least one plastic rectangular layer having a width of about 2.5 inches and a length of about 3.5 inches and having a pattern of digital data encoded thereon. Prior to this molding step, however, and as understood by those skilled in the art, data for the disc is optically, e.g., preferably by laser techniques, mastered from data files or other software programs. The master is then electroplated with a metal material, e.g., silver and prepped for replicating positive mold copies or shims. Die stampers are produced from the electroplated shims. The plastic layer is then formed by injection molding from a negative image on the die stamper.

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(Published Application, Page 4, para. 38). Thus unlike Rhode, which discloses the use of a blank that then has material removed, Applicants disclose a method of layering or injection molding the non-functional portion of the disc to the major elevational layer including the digitally encoded information. In essence, Rhode is aimed at removing material from a blank to achieve a non-round shape, and Applicants' method is aimed at adding material to achieve a non-round shape. Therefore, while both Applicants and Rhode produce a non-round disc, their method of achieving related results are polar opposites, and one skilled in the art would not readily make a leap of faith without some additional suggestion or motivation to produce a non-round disc by the addition of layer or material through an injection molding process. Furthermore, the Examiner has not identified or even hinted at where this suggestion or motivation to add material instead of removing material is found in either Rhode or any other source.

Applicants respectfully reminds the Examiner that the Examiner should not "read obviousness into an invention on the basis of the Applicants's own statements," and "must view the prior art without reading into that art [Applicants's] teachings." See *In re Spinnoble*, 405 F.2d 578, 585 (1969). Unfortunately, Applicants submits that is exactly what the Examiner has done with this application. Nothing in the Rhode teaches, suggests, or even hints that an alternate method to grinding down a blank to form a non-round disc is to add additional layers or material. Applicant submits that Rhode, if anything, teaches away from Applicants claimed invention. See *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Similar to *In re Gordon* where the Federal Circuit reversed the Board's determination that turning an invention upside down that uses gravity as a separator for fluids would not have rendered the claimed invention obvious, adding material or layers would be inconsistent with the disclosures and teachings in Rhode for removing material from a blank. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). It would not have been readily apparent to one skilled in the art that the invention disclosed, taught and claimed in Rhode could be modified to a method of adding material or layers to form a non-round disc unless Applicants' patent application was used as a road map to go in the opposite direction of Rhode. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); MPEP 2143.01. Thus, the Examiner has improperly "read obviousness into an invention on the basis of [Applicants's] own statements," and the Examiner has rejected Applicants' application over

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Rhode only after reading Applicants' teachings into what is disclosed, taught, and claimed by Rhode. See *In re Sponnoble*, 405 F.2d 578, 585 (1969). Additionally, Applicants observes that this situation appears to be similar to *In re Ratti* where the CCPA reversed the Board when the prior art taught resiliency and the patentee claimed rigidity. *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959).

Based on the facts of this situation, on precedential US patent law, and reasonable conclusion drawn from the facts, Applicants respectfully submits that the Examiner has failed to meet the Examiner's burden for establishing the first factor of a *prima facie* case for an obviousness rejection of Applicants' independent Claim 42.

No Reasonable Expectation of Success:

Second, as the Examiner is aware, there must be a reasonable expectation of success. See, e.g., *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989); MPEP § 2143.02. From the discussion above, one skilled in the art would not appreciate based on Rhode that a method for forming a non-round disc could be achieved by adding layers or material instead of removing material from a blank. It would be counterintuitive and illogical for the Examiner to argue that the suggestion of a completely opposite method would equate with a reasonable expectation of success.

Additionally, there must be some degree of predictability to sustain a rejection based on obviousness. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re O'Farrell*, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988); MPEP § 2143.02. Unlike *In re O'Farrell*, Rhode does not contain an enabling methodology, a suggestion or motivation to modify the prior art to achieve Applicants' claimed invention, and evidence suggesting the modification would be successful. *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

Based on the facts of this situation, and based on precedential US patent law, Applicants respectfully submits that the Examiner has failed to meet the Examiner's burden for establishing the second factor of a *prima facie* case for an obviousness rejection of Applicants' independent Claim 42.

Applicants would further note that Rhode does not contain both (1) a suggestion or motivation to modify the reference and (2) a reasonable expectation of success not based on Applicants' disclosure as required by the US patent law. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d

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1438 (Fed. Cir. 1991); *see also* MPEP 706.02(J). As such, Applicants respectfully submit the Examiner's rejection again fails to meet the Examiner's burden to establish either alone or in combination the first or second factors of a *prima facie* case for an obviousness rejection of Applicants' independent Claim 42.

Prior Art Does Not Include All Claim Limitations:

Finally, as the Examiner is aware, the prior art reference must teach or suggest all claim limitations to establish a *prima facie* case for obviousness. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); MPEP § 2143.03. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of [a] claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); MPEP § 2143.03. Therefore, if any independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending upon that independent claim is also nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP § 2143.03. Rhode does not describe or suggest, at least, a method of forming or "molding a compact disc having a pattern of digital data encoded on a surface having a major elevational portion bounded by first and second pairs of spaced-apart outer side peripheries defining outer boundaries of at least portions of the disc, each of the first pair of spaced-apart peripheries arcuately extending between each of the second pair of spaced-apart outer side peripheries extending substantially linearly between each of the pairs of spaced-apart outer peripheries." Most notably, Rhode does not include "a compact disc having a pattern of digital data encoded on a surface having a major elevational portion."

Therefore, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness because, as a minimum, Examiner has not shown: (i) some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference; (ii) a reasonable expectation of success; or (iii) a teaching or suggestion of all claim limitations.

Accordingly, independent Claim 42 has been shown to be novel, nonobvious, and allowable with respect to the cited art. Correspondingly, dependent Claims 43 has likewise been shown to be allowable. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP § 2143.03.

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Therefore, Applicants respectfully submits that based on the foregoing remarks, Claim 42-43 are novel, nonobvious and patentable in view of Rhode.

In commenting upon the Examiner's objections herein in order to facilitate a better understanding of the differences that are expressed in the claims, certain details of distinction between the Examiner's arguments and the present invention have been mentioned, even though such differences do not appear in all of the claims. It is not intended by mentioning any such unclaimed distinctions to create any implied limitation in the claims. Not all of the distinctions between the Examiner's objections and Applicants' present invention have been made by Applicants. For the foregoing reasons, Applicants reserve the right to submit additional evidence showing the distinctions between Applicants' invention to be novel, unobvious, and patentable over the prior art of Examiner's objections, including without exception those in the most recent office action and previous office actions.

The foregoing remarks are intended to assist the Examiner in re-examining the application and in the course of explanation may employ shortened or more specific variants descriptions of some of the claim language. Such descriptions are not intended to limit the scope of the claims; the actual claim language should be considered in each case. Furthermore, the remarks are not to be considered to be exhaustive of the facts of the invention, which render it patentable, being only examples of certain advantageous features and differences that Applicants' attorney chooses to mention at this time.

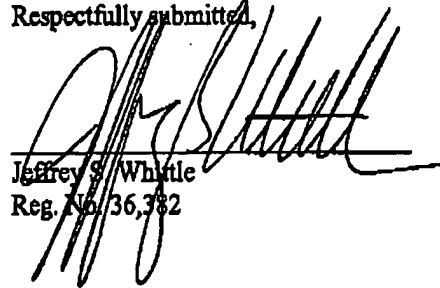
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CONCLUSION

In view of the amendments and remarks without prejudice set forth herein, Applicants respectfully submits that the application is in condition for allowance. Accordingly, the issuance of a Notice of Allowance in due course is respectfully requested.

Respectfully submitted,


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